

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of: Eric Yang, et al	)	Confirmation No.: 7816
	)	
Serial No.: 09/854,306	)	Examiner: Janice A. Mooneyham
	)	
Filing Date: May 11, 2001	)	Art Unit: 3629

For: Software Licensing Management System

MS Appeal Brief-Patents  
Commissioner for Patents  
P.O. Box 1450  
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**REPLY BRIEF**

Sir:

This is in response to the Examiner's Answer mailed November 15, 2007. The shortened statutory period runs until January 15, 2008.

## REMARKS

1. As is discussed on pages 8-10 of the Appeal Brief, Claim 1 recites, among other features, “sending license parameters from said management system over said network to a licensing host that (a) is coupled to said management system via said network, (b) communicates with said first set of software over said network, and (c) enforces said license parameters relative to said first set of software.” Thus, according to Claim 1, the “license parameters” must be sent to a “licensing host.” However, the “licensing host” to which the “license parameters” must be sent is not just **any** thing that could be interpreted as a “host.” The “licensing host” to which the “license parameters” must be sent is, **specifically**, a “licensing host” that has the **specific** qualities that are recited in Claim 1. Among other qualities, the “licensing host” recited in Claim 1 must be a kind of “licensing host” that **actually communicates with software over a network** (and not just any software—the software with which the “licensing host” communicates must have the quality of being the **same** software that the client’s inquiry regards). The Appellants argue in the Appeal Brief that Ginter does not disclose a licensing host that has these particular qualities.

These qualities of the licensing host, recited in Claim 1, serve to narrow the reasonable interpretation of what the Examiner can call a “licensing host.” No doubt, if Claim 1 did not recite these specific qualities, then the Examiner would be free to cite a great many diverse things that are discussed in Ginter, and speculate that any of those things could be a “licensing host.” Based on the Examiner’s Answer, it appears that the Examiner is trying to convince the Honorable Board to ignore these expressly recited qualities of the “licensing host” so that the Examiner will be free to contend that something that does **not** have these qualities is recited in Ginter and is somehow a “licensing host” of some kind when interpreted in an extremely broad sense.

It is telling that the Examiner does not attempt to argue, at least initially, that Ginter actually discloses some “licensing host” that has the specific qualities that are recited in Claim 1.

Instead, the Examiner attempts to argue, in essence, that Claim 1 does not actually recite these specific qualities, or that, for some odd reason, the recitation of these specific qualities should not be given any patentable weight. The Appellants respectfully propose that the lack of any argument, by the Examiner, that Ginter actually discloses the specific “licensing host” qualities that are recited in Claim 1, is indicative that Ginter does not actually disclose a licensing host that **actually communicates, over a network, with software that the client’s licensing inquiry regards.**

On page 20 of the Examiner’s Answer, under the heading “Step 5,” the Examiner argues that “While appellant states that the licensing host is coupled to the management system and communicates with the first set of software over a network and enforces licensing parameters, appellant has not positively claimed the step of communicating with the first set of software or enforcing the parameters.” The Appellants respond that this contention is without any basis in fact or law. Claim 1 clearly recites the limitation that the “licensing host” have the specific qualities of communicating with the first set of software over the network and enforcing the licensing parameters. It should not make any difference, to the patentability of Claim 1, that the Appellants did not, instead, recite something like “said licensing host communicating with the first set of software over a network” and “said licensing host enforcing said parameters.” The bottom line is that Claim 1 **requires** the presence and involvement of a “licensing host” that actually does performs these actions. Simply put, if Ginter does not disclose a “licensing host” that performs all of the operations and has all of the qualities that the “licensing host” of Claim 1 performs and has, then Ginter **does not** render Claim 1 unpatentable. It would be grossly unfair to ignore these expressly recited aspects of Claim 1; the recital of such features is the only mechanism that the Appellants have to distinguish their claimed subject matter over cited prior art. Claim features should not be ignored merely because of the form in which they appear.

Even if Ginter discloses something that is somewhat like a licensing host of some kind, Ginter simply does not disclose a “licensing host” of the specific kind that is recited in Claim 1.

Again, there is no “licensing host” in Ginter that has all of the qualities that the “licensing host” of Claim 1 has. The Appellants urge the Honorable Board to give **all** of the expressly recited features of the “licensing host” of Claim 1 patentable weight, as is proper under the law, and **reverse** the Examiner’s rejection of Claim 1.

As for the Examiner’s arguments regarding the other features of Claim 1, the Appellants respectfully submit that these arguments are irrelevant to the issue of whether Ginter recites a licensing host that communicates, over a network, with software whose licensing a client’s network-sent inquiry regards.

2. In the Examiner’s Answer, on page 24 and several pages preceding, the Examiner argues that “clearly computer software is content anticipated by Ginter.” However, the Appellants never argued that Ginter’s VDE container could not contain and protect computer software. Rather, the Appellants have argued that Ginter’s does not disclose any licensing host that communicates, over a network, with computer software that is protected by such as VDE container. The question of whether or not Ginter’s VDE container can encapsulate and protect computer software is irrelevant to the issue of whether of not Ginter discloses a licensing host that communicates with such software. The Appellants respectfully submit that, even if Ginter discloses some kind of mechanism for enforcing agreements pertaining to the licensing of computer software, that mechanism still does not enforce those agreements in the manner specifically recited in Claim 1.

3. Instead of the specific method disclosed in Claim 1, Ginter’s VDE system appears to involve code that travels with and encapsulates the content that the code protects. Any attempt by some party to access the protected content appears to involve communication with the encapsulating code, **not** with the protected content itself. Furthermore, since the code apparently travels with content that the code protects, there really is no reason, in Ginter’s approach, why any licensing host would **communicate over a network** with the protected content (or even the

code that protects such content). Therefore, even if the protected content itself was computer software, the general VDE approach that Ginter uses to protect that computer software would not involve any licensing host communicating with that computer software over a network.

4. On page 31 of the Examiner's Answer, the Examiner argues that the "management system" of Claim 1 could be either VDE or an "information utility" or a distributor/publishing house, or a content provider. Yet, according to Claim 1, the recited "management system" must be (a) **embodied in a machine**—which excludes at least the distributor/publishing house and content provider, and (b) **send licensing parameters over a network to a licensing host that communicates with the set of software which the client's licensing inquiry regards**. None of the many entities to which the Examiner points as potential analogous to the "management system" send license parameters over a network to a licensing host that communicates with a set of software that a client's licensing inquiry regards, even if these entities somehow communicate with each other, and even if such communication involves a computer network. As is discussed above, Ginter does not disclose a licensing host that has all of the qualities that are recited in Claim 1. It follows, therefore, that Ginter does not disclose a management system that sends license parameters to such a licensing host over a network.

5. On page 39 of the Examiner's answer, the Examiner asserts that the "licensing host" of Claim 1 can be any mechanism that communicates over an "electronic highway" to the content/software. The Examiner then proposes that the VDE itself or VDE applications and software are candidates that are such mechanisms. However, VDE itself does not communicate over an "electronic highway" or any other network with the content that the VDE protects (because VDE travels with the content, VDE has no need to communicate **over a network** with the content that VDE protects), so VDE cannot be the "licensing host" of Claim 1. Additionally even if Ginter discloses that the VDE applications and software interact with VDE in order to

access the content that VDE protects, Ginter does not disclose that such VDE applications and software ever **communicate with** the content that VDE protects.

Although Ginter discloses that VDE can protect a variety of electronic content, including computer software, Ginter's VDE system is clearly generalized so that the system can protect electronic content of virtually any type, including content that is **not** software and content that **has no ability to communicate** with any other entity. Under many circumstances in which the VDE-protected content is **not** software (e.g., when the VDE-protected content is pure data that represents music, an image, or a movie), the VDE-protected content is **incapable** of communicating with any entity—even a “licensing host.” Ginter's approach protects different kinds of content using the same general mechanisms. Thus, Ginter's approach protects software content in the same manner that Ginter's approach protects non-software content like music, images, and movies. Clearly, when the VDE-protected content is not software, no “licensing host” can communicate with that VDE-protected content. Despite Ginter's voluminous size, the Applicants contend that Ginter apparently never discloses that VDE handles software content any differently than VDE handled non-software content.

The Appellants wish to reiterate that, even if Ginter discloses a mechanism that communicates with a VDE “container” that is “wrapped around” the protected content, it does **not** follow from this that Ginter also discloses that such a mechanism communicates with the protected content **itself**, let alone over a computer network.

6. On page 41 of the Examiner's Answer, the Examiner writes that “Appellant's primary argument appears to be that Ginter does not disclose license parameters being sent over a network from a management system to a licensing host that is coupled to the management system via the network.” That is not a completely accurate assessment of the Appellant's primary argument, and, not surprisingly, once again apparently attempts to ignore the significant features of the “licensing host” that are recited in Claim 1. As is discussed above, the Appellants are actually arguing, more specifically (in addition to any other arguments), that Ginter does not

disclose license parameters being sent over a network from a management system to a licensing host that is (a) coupled to the management system via the network **and (b) that communicates with the software that the client's licensing inquiry regards**. Ginter does not disclose this more specific feature.

Indeed, as is discussed in the Appeal Brief on page 9, the Examiner has already admitted, in the Advisory Action mailed on April 24, 2007, that, in Ginter's approach, "**no system communicates** with the content." Surely, the Examiner is not now, at this late stage, warranting the taking of a contrary position.

Additionally, the licensing host of Claim 1 also must enforce the license parameters relative to the set of software with which the licensing host communicates. Even if one or more of these entities that Ginter discloses communicates with a set of software over a network, these are not the same entities that enforce licensing parameters relative to the set of software. Under Ginter's approach, the VDE "container" does not communicate with the content that the VDE "container" protects. Therefore, even if the VDE "container" enforces licensing parameters, the VDE "container" cannot be the "licensing host" of Claim 1. None of the other entities disclosed in Ginter can be the "licensing host" of Claim 1 because none of these other entities enforces licensing parameters relative to the content that the VDE "container" protects (that, apparently, would be the goal of the VDE "container" itself, so there really is no reason why any of the other entities would need to enforce any licensing parameters relative to the content).

For at least the above reasons, and those set forth in the Appeal Brief previously filed, Appellants respectfully submit that the imposed rejections are **not** viable, and respectfully solicit the Honorable Board to **reverse** each of the imposed rejections.

Respectfully submitted,

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Dated: January 15, 2008

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